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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/757,148

01/14/2004

Tamon Itahashi

600630-12US (562723)

3156

570

7590

05/25/2006

AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER

SHIAO, REI TSANG

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/757,148	<b>Applicant(s)</b> ITAHASHI ET AL.	
	<b>Examiner</b> Robert Shiao	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 5 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/18/04, 1/14/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This application claims benefit of the foreign applications:

JAPAN 2003-009637 with a filing date 01/17/2003; and

JAPAN 2003-11282 with a filing date 04/16/2003.

2. Claims 1-10 are pending in the application.

### ***Information Disclosure Statement***

3. Applicant's Information Disclosure Statements, filed on October 18, 2004, or January 14, 2004, have been considered. Please refer to Applicant's copy of the 1449 submitted herein.

### ***Responses Election/Restriction***

4. Applicant's election with traverse of Group III claims 5-6, in the reply filed on April 17, 2006, is acknowledged. Additionally, an elected single species of a compound of formula (i) wherein R<sup>3</sup> represents methyl and R<sup>4</sup> represents hydrogen, is also acknowledged. The traversal is on the grounds that (1) the Examiner has not set forth a proper basis for restricting the invention of Group III from the inventions of Group I and Group II; or (2) applicants respectfully submit that any complete search covering methods of producing a cross-coupling compounds of formula (3)(i.e., Groups I-II) or the catalyst (i.e., Group III), will almost certainly necessitate a search. This is not found persuasive and reasons are given, *infra*.

Claims 1-10 are pending in the application. The scope of the invention of the elected subject matter is as follows.

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Claim 5-6, drawn to catalyst of formula (i).

The withdrawn processes of making of Groups I-II, contain varying aryl, heterocycle or heteroaryl of the variable  $R^2$  of the formula (3) having phenyl, morpholine, pyridyl, or piperazine moiety, which differ from those of the elected invention having imidazole moiety, which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classifications of these functional groups in the U.S. classification system, i.e., class 568 subclass 579 (+) (phenyl), class 544 subclass 106(+) (morpholine), class 546 subclass 249(+) (pyridyl), class 544 subclass (336+) (piperazine), etc. Therefore, again, the compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in common structure/composition and have been restricted properly.

The group set forth in the claims includes both independent and distinct inventions, i.e., process of making compounds of formula (3), and patentably distinct compounds (or species), i.e., compounds of formula (i), within each invention. However, this application discloses and claims a plurality of patentably distinct inventions far too numerous to list individually. Moreover, each of these inventions contains a plurality of patentably distinct compounds, i.e., compounds of formula (1)-(3) or (i), also far too numerous to list individually. Moreover, the examiner must perform a commercial database search on the subject matter of each group in addition to a paper search, which is quite burdensome to the examiner.

Claims 5-6 of the elected subject matter are prosecuted in the case. Claims 1-4

and 7-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper.

### ***Claim Objections***

5. Claims 5-6 are objected. Incorporation of the formula (i) of the catalyst into claim 5 and amendment of claim 5 as an independent claim would obviate the objection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao, Ph. D. whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Joseph K. McKane".

for Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626

Robert Shiao, Ph.D.  
Patent Examiner  
Art Unit 1626

May 22, 2006